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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,233	11/03/2003	James Michael Quackenbush	019377-00100	3765

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John Wilson Jones
Attn: IP Docketing Clerk
Locke, Liddell & Sapp LLP
600 Travis, Suite 3400
Houston, TX 77002

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/700,233	Applicant(s) QUACKENBUSH, JAMES MICHAEL	
	Examiner Vickey Ronesi	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-32, 34, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-32, 34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2007 has been entered.
2. No new grounds of rejection are set forth below because the claims were not amended in the submission filed on 12/21/2007. Thus, the following action is properly made final.
3. The outstanding claim objections are withdrawn in light of applicant's arguments filed on 12/21/2007.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
5. Claims 1, 4-11, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (JP 05-238799, machine translation) in view of Wooster et al (US 3,341,555) and Inoue (US 5,422,391).

The rejection is adequately set forth in paragraph 5 of Office action mailed on 6/21/2007 and is incorporated here by reference.

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6. Claims 2, 3, 12, 15-31, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (JP 05-238799, machine translation) in view of Wooster et al (US 3,341,555) and Inoue (US 5,422,391) and further in view of Traverso et al (US 5,280,051).

The rejection is adequately set forth in paragraph 6 of Office action mailed on 6/21/2007 and is incorporated here by reference.

7. Claims 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (JP 05-238799, machine translation) in view of Wooster et al (US 3,341,555) and Inoue (US 5,422,391) and further in view of Platka et al (US 4,244,993).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 6/21/2007 and is incorporated here by reference.

8. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (JP 05-238799, machine translation) in view of Wooster et al (US 3,341,555) and Inoue (US 5,422,391) and further in view of Traverso et al (US 5,280,051) and Platka et al (US 4,244,993).

The rejection is adequately set forth in paragraph 8 of Office action mailed on 6/21/2007 and is incorporated here by reference.

Response to Arguments

9. Applicant's arguments filed 12/21/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Sasaki requires extended setting times with heat and pressure, wherein the instant invention does not use heat or pressure; (B) Wooster

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obviates the needs for high-temperature curing epoxy mixtures and hence a heat-activated catalyst; (C) that Inoue does not disclose the presently claimed mixture of inorganic fillers with the claimed particle diameters; (D) that Inoue has a much greater percent filler than applicant's composition; and (E) that Traverso et al fails to disclose the presently claimed particle diameters and Platka et al discloses a sprayable composition, which is not like that presently claimed.

With respect to argument (A), first, it is noted that the features upon which applicant relies (i.e., no extended setting time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, the claims do require heat because the claims require a heat-activated catalyst.

With respect to argument (B), Wooster provides teachings that mixtures of aromatic and alicyclic carboxylic acid anhydrides are stable homogeneous liquid composition at ambient temperatures. This does not preclude the curing at elevated temperatures because these teachings are only to storage stability and not to curing the resin. In fact, Wooster teaches heating to curing temperatures (col. 3, lines 3-13). Wooster et al further teaches suitable amines as cure activator (col. 4, line 60 to col. 5, line 6), which include polyamines and imidazoles (like presently claimed), and are activated upon heating. Furthermore, while Wooster utilizes a mixture of carboxylic acid anhydrides for a different reason than applicant, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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With respect to argument (C), the particle diameters taught by Inoue overlap with the presently claimed particle diameters. Specifically, Inoue's fine particle (> 210 microns) reads on the presently claimed inorganic filler having a particle size of greater than 90 microns and Inoue's very fine particle (< 149 microns) reads on the presently claimed inorganic filler having a particle size of 10-40 microns. Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With respect to argument (D), it is noted that the features upon which applicant relies (i.e., total amount of filler) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to argument (E), while Traverso et al and Platka et al do not disclose all the features of the present claimed invention, they are used as teaching reference, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. Specifically, Traverso et al is relied upon for its teaching regarding the use of granite and silica sand in preparing

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artificial marble products and Platka et al is relied upon to teach the use of artificial marble products in a countertop.

Conclusion

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/28/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/
Supervisory Patent Examiner, Art Unit 1796